

REMARKS

Claims 9-13 and 18-28 are currently pending in the subject application, and are presently under consideration. Claims 9-13 and 18-28 are rejected. Favorable reconsideration of the application is requested in view of the amendments and comments herein.

Claims 9-10 and 18 have been amended to correct formal matters.

It is respectfully submitted that the Office Action mistakenly reports that claims 25 and 27 are rejected under 35 U.S.C. §102(b). Specific reasons for the rejection of claims 25 and 27 are given in a rejection under 35 U.S.C. §103(a). Thus, Applicant will respond to the rejection of claim 25 and 27 under 35 U.S.C. §103(a).

I. Rejection of Claims 9-13, 18-24, 26 and 28 Under 35 U.S.C. §102(b)

Claims 9-13, 18-24, 26 and 28 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,757,920 to Misra, *et al.* ("Misra"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Amended claim 9 recites encrypting all certificates/private keys of a plurality of certificates/private keys which have not been downloaded to a token using a public key associated with the token identification in the database to form a download packet, downloading the download packet to the token, and activating the certificates/private keys in the download packet using a private key in the token.

Misra does not anticipate amended claim 9. Misra does not disclose encrypting all certificates/private keys of a plurality of certificates/private keys which have not been downloaded to a token using a public key associated with the token identification in a database to form a download packet, as recited in amended claim 9. Misra discloses that if a user decides to logon using a logon certificate that is contained in a removable storage media, the user must provide a downloading password he was required to enter when downloading the certificate onto the removable storage media (See Misra, Col. 8, Lines 15-21). Misra does not disclose a public key associated with a token identification in a database. Thus, Misra does not disclose encrypting certificates/private keys using a public key associated with a token identification in a

database to form a download packet, as recited in amended claim 9. Additionally, Misra does not disclose downloading the download packet to the token. Misra discloses that a user may download a logon certificate onto removable storage media such as a floppy diskette (See Misra, Col 6, Lines 63-67). Misra also discloses that a one way hashing function is used to hash the password, which is used to generate an encryption key, which in turn it used to encrypt the logon certificate (See Misra. Col. 6 Line 68-Col. 7 Line3). As stated above, Misra does not disclose the download packet recited in amended claim 9. Thus, Misra does not disclose downloading the download packet to the token, as recited in amended claim 9.

Additionally, Misra does not disclose activating certificates/private keys using a private key in the token, as recited in amended claim 9. Misra discloses that a logon process uses a password to generate an encryption key using a pre-specified and fixed algorithm (See Misra, Col. 8, Lines 27-28). Misra further discloses that the key is used to decrypt the logon certificate retrieved from a removable storage media or from a machine itself (See Misra, Col, 8, Lines 29-31). Misra does not disclose a private key in a token, as recited in amended claim 9. Thus, Misra does not disclose activating certificates/private keys in a download packet using a private key in a token, as recited in amended claim 9. Accordingly, Misra does not disclose each and every element of amended claim 9. Thus, Misra does not anticipate amended claim 9, and therefore, amended claim 9 should be patentable over the cited art.

Claims 10-13 and 24 depend either directly or indirectly from amended claim 9 and are patentable over the cited art for at least the same reasons as amended claim 9 and for the specific elements recited therein. Accordingly, claims 10-13 and 24 should be patentable over the cited art.

Additionally, Misra does not disclose activating certificates/private keys further comprising the entry of a passphrase, as recited in claim 23. As stated above, claim 23 depends from amended claim 9. Amended claim 9, from which claim 23 depends, recites activating the certificates/private keys in a download packet using a private key in a token. Thus, claim 23 recites (by virtue of its dependence from amended claim 9) activating certificates/private keys by using a private key in a token and entering a passphrase. It is respectfully submitted that in

rejecting claim 23, the Office Action attempts to use the same aspect of Misra (a downloading password) that was used in the rejection of claim 9 for disclosing two separate elements recited in claim 23, namely, the private key and the entry of a passphrase. The United States Court of Appeals for the Federal Circuit ("Federal Circuit") has held that the doctrine of claim differentiation dictates that where claims use different terms, those differences are presumed to reflect a difference in the scope of the claims. *Forest Laboratories, Inc. v. Abbott Laboratories*, 239 F.3d 1305, 1310, 57 U.S.P.Q.2d 1794 (Fed. Cir. 2001). If both the private key and the passphrase were considered to be the same element, claim 23 would be superfluous. Thus, it is respectfully submitted that claim 23 is not given independent patentable weight. Accordingly, Misra does not disclose each and every element of claim 23.

Regarding amended claim 18, Misra does not anticipate amended claim 18 for substantially the same reasons as amended claim 9. As stated above with respect to amended claim 9, Misra does not disclose encrypting all certificates/private keys of a plurality of certificate/private keys which have not been downloaded to a token using a public key associated with the token identification in a database to form a download packet, downloading the download packet to the token and activating the certificates/private keys using a private key in the token, as recited in amended claim 18. Thus, Misra does not disclose each and every element of amended claim 18. Accordingly, Misra does not anticipate amended claim 18, and therefore, claim 18 should be patentable over the cited art.

Claims 19-22, 26 and 28 depend either directly or indirectly from amended claim 18 and are patentable for at least the same reasons as amended claim 18 and for the specific elements recited therein. Thus, claims 19-22, 26 and 28 should be patentable over the cited art.

Additionally, claim 26 is not anticipated by Misra for substantially the same reasons as claim 23. That is, by virtue of the doctrine of claim differentiation, Misra does not disclose that activating occurs in response to a receipt of a passphrase, as recited in claim 26. Accordingly, Misra does not disclose each and every element of claim 26.

For the reasons described above, claims 9-13, 18-24, 26 and 28 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 13, 22, 25 and 27 Under 35 U.S.C. §103(a)

Claims 13, 22, 25 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Misra in view of U.S. Patent No. 6,192,131 B1 to Geer, Jr., *et al.* ("Geer"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 13 and 25 depend from amended claim 9. Thus, claim 13 and 25 are patentable for at least the same reasons as amended claim 9 and for the specific elements recited therein. The addition of Greer does not cure the deficiencies of Misra. Greer also does not teach or suggest encrypting all certificates/private keys of a plurality of certificate/private keys which have not been downloaded to a token using a public key associated with the token identification in a database to form a download packet, downloading the download packet to the token and activating the certificates/private keys using a private key in the token, as recited in amended claim 9, from which claims 13 and 25 depend.

Additionally, regarding claims 13 and 25, it is respectfully submitted that there is no motivation to combine and modify the teachings of Misra and Greer in the manner suggested by the Office Action. Misra provides no teaching or suggestion to implement smart cards. Greer provides no teach or suggestion for the distribution of logon certificates. The Federal Circuit has held that it is insufficient to establish obviousness by showing that the separate elements existed in the prior art, absent some teaching or suggestion in the prior art to combine the elements. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 43 U.S.P.Q.2d 1294 (Fed. Cir. 1997). It is respectfully submitted that without using improper hindsight, one skilled in the art would not combine and modify the teachings of Misra and Greer in the manner suggested by the Office Action. Thus, Misra taken in view of Greer, does not make claims 13 and 25 obvious.

Claims 22 and 27 depend from amended claim 18 and are patentable for at least the same reasons as amended claim 18 and for the specific elements recited therein. The addition of Greer does not cure the deficiencies of Misra. Greer also does not teach or suggest encrypting all certificates/private keys of a plurality of certificate/private keys which have not been downloaded to a token using a public key associated with the token identification in a database to

form a download packet, downloading the download packet to the token and activating the certificates/private keys using a private key in the token, as recited in amended claim 18, from which claims 22 and 27 depend. Additionally, as stated above with respect to claims 13 and 25, there is no motivation to combine and modify the teachings of Misra and Greer in the manner suggested by the Office Action. Thus, Misra taken in view of Greer does not make claims 22 and 27 obvious.

For the reasons described above, claims 13, 22, 25 and 27 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

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CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

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